

**REMARKS**

Claims 1-39 are presently pending.

Claims 9-11, 13-19, 22, and 25 stand provisionally rejected under 35 U.S.C. § 101 as allegedly claiming the same invention as claims 9-11, 12-18, 26, and 40 of co-pending application no. 09/417,774 ("the '774 application").

Claims 1, 24, 29, 30 and 34 stand provisionally rejected on the ground of nonstatutory double patenting over claims 1, 27, 32, and 36 of the '774 application.

Claims 2-8, 12, 20-21, 23, 26-28 31-33 and 35-39 are indicated as rejected on the summary page of the Office Action, but no reason for rejection is provided in the Office Action. Accordingly, Applicant considers these claims patentable. *E.g., 35 U.S.C. §102 ("A person is entitled to a patent unless ....).*

Applicants request reconsideration.

***The Telephone Interview***

The Examiner contacted Applicants' representative on February 15, 2006 proposing that claim 1 be amended to incorporate the subject matter of dependent claims 10 and 13. The Examiner indicated that he would be willing to allow claim 1, if amended as proposed. The Examiner stated that he was considering U.S. Patent Nos. 6,317,728, 6,236,321, and 5,884,286, and an article by Joubert and Rogers. The Examiner stated that he did not have a copy of the Joubert and Rogers article. Applicants note that the Examiner has not cited these references in connection with the present application. It appears that, upon further consideration, the

Examiner did not consider these references to be relevant. In any event, Applicants cite these references in an Information Disclosure Statement filed herewith.

In a subsequent telephone call on the same date, the Examiner indicated that if the subject matter of claims 10 and 13 could be added to the other independent claims of the present application, he would consider those claims to be allowable.

On February 16, 2006, Applicants' representative left a voice mail message for the Examiner declining the offer to amend the claims and requesting that the Examiner mail an Office Action if he considered the claims to be unpatentable over the prior art.

***Claims 2-8, 12, 20-21, 23, 26-28, 31-33 and 35-39 Are Allowable***

The Office Action does not assert any rejections or objection to claims 2-8, 12, 20-21, 23, 26-28 31-33 and 35-39. 37 C.F.R. § 1.104(c)(1) provides that "[I]f an invention is not considered patentable, or not considered patentable as claimed, the claims, or those considered unpatentable will be rejected." Because claims 2-8, 12, 20-21, 23, 26-28, 31-33 and 35-39 are not rejected, they are allowable.

***The Rejection of Claims 1, 24, 29, 30 and 34***

The Office Action provisionally rejects claims 1, 24, 29, 30 and 34 under the judicially-created nonstatutory "obviousness-type" double patenting. The reason provided in the Office Action for the provisional rejection is that the present application and the '774 application are claiming "common subject matter," namely "an automated trading system for use in an electronic exchange network." However, the Office Action does not compare the text of the claims in the

present application to the text of the claims of the '774 application or explain why the differences would have been obvious.

While not conceding the propriety of the rejection or the sufficiency of the Office Action, Applicants submit herewith a terminal disclaimer obviating the rejection.

***The Rejection of Claims 9-11, 13-19, 22, and 25***

Dependent claims 9-11, 13-19, 22, and 25 stand provisionally rejected under 35 U.S.C. § 101 as allegedly claiming the same invention as claims 9-11, 12-18, 26, and 40 of the '774 application. Applicants disagree.

Claims 9-11, 13-19 and 22 are dependent claims that incorporate independent claim 1, either directly or through another dependent claim. The Examiner apparently compared the text of dependent claims 9-11, 13-19, 22, and 25 to claims of the '774 application without considering the incorporated subject matter. When the claims are considered with the incorporated subject matter, it is clear that claims 9-11, 13-19 and 22 differ from claims 9-11, 12-18, 26, and 40 of the '774 application. In fact, the Office Action acknowledges that independent claim 1 is directed to a different invention than claim 1 of the '774 application by asserting an "obviousness-type" rejection. Because claims 9-11, 13-19 and 22 differ from the claims of the '774 application, the rejection under 35 U.S.C. § 101 is improper.

Similarly, claim 25 is a dependent claim that incorporates claim 24. When the incorporated subject matter is considered, it is clear that claim 25 differs from claim 40 of the '774 application. Because the claims differ, the rejection under 35 U.S.C. § 101 is improper.

The provision rejection of claims 9-11, 13-19, 22, and 25 should be withdrawn.


***Conclusion***

**Except** for issue fees payable under 37 C.F.R. 1.18, the Commissioner is hereby authorized by this paper to charge any additional fees during the entire pendency of this application including fees due under 37 C.F.R. 1.16 and 1.17 which may be required, including any required extension of time fees, or credit any overpayment to Deposit Account No. 50-0310.

This paragraph is intended to be a **CONSTRUCTIVE PETITION FOR EXTENSION OF TIME** in accordance with 37 C.F.R. §1.136(a)(3).

Respectfully submitted,

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